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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/500,665

06/28/2004

Arturo Leone

206,588

3094

7590

11/14/2006

Jay S Cinamon
Abelman Frayne & Schwab
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New York, NY 10017

EXAMINER

STOICA, ELLY GERALD

ART UNIT

PAPER NUMBER

1647

DATE MAILED: 11/14/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/500,665

Applicant(s)

LEONE ET.AL.

Examiner

Elly-Gerald Stoica

Art Unit

1647

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 30-62 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 30-62 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☒ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>08/25/2005</u> . | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

Election/Restrictions

1. Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, claims 30-33 (in part), 35-38, 46 (in part), 47, 48, 49-52 (in part), 53 and 62 (in part), drawn to isolated antibodies against peptides of defined sequence, compositions containing them, the mode of obtaining them and mode of use.

Group II, claims 30-33 (in part), 39-43, 46 (in part), 49-52 (in part) and 62 (in part), drawn to antisense nucleotides that recognize defined polynucleotide sequences, compositions containing them and the mode of obtaining them.

Group III, claims 44-45 (in part), and 34 drawn to defined polynucleotide sequences.

Group IV, claims 44-45, drawn to defined peptide sequences.

Group V, claims 54, 56, 58 (all in part) drawn to a method of treatment of a cell death-involving disease or modulating apoptosis comprising administering an antibody.

Group VI, claims 54, 56, 58 (all in part) drawn to a method of treatment of a cell death-involving disease or modulating apoptosis comprising administering an antisense oligonucleotide.

Art Unit: 1647

Group VII, claims 55, 57 and 59 (all in part) drawn to a method of treatment of a cell death-involving disease or modulating apoptosis comprising administering a polynucleotide.

Group VIII, claims 55, 57 and 59 (all in part) drawn to a method of treatment of a cell death-involving disease or modulating apoptosis comprising administering a polypeptide

Group IX, claims 60 drawn to a method of detection of a protein

Group X, claim 61, drawn to a method of detection a compound that binds proteins of defined sequences.

2. The inventions listed as Groups I-X do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: the antisense polynucleotides, the antibodies against the recited peptide sequences the corresponding peptide sequences are known in the art and do not represent special technical features (WO 00 14106, page 20, line 23 to page 21, line 2, page 23, line 6 to page 24, line 22 ; WO 95 25125, page 1, line 3 to page 2, line 5, page 3 lines 13-19, page 4, line 32 to page 5, line 3, page 11, line 33 to page 12, line 4, page 13, line 33 to page 15, line 6, page 26, line 1 to page 30- line 7, and page 31, lines 16-26). Therefore unity of invention is lacking.

3. This application contains claims directed to more than one species. No claim is generic since there is no common structure or function related thereto. These species

Art Unit: 1647

are deemed to lack unity of invention because they are not so linked as to form a single general inventive concept under PCT Rule 13.1.

Regardless of which invention is elected, the Applicant is required, in reply to this action, to elect a single species from the SEQ. ID. Nos.: 2, 4, 6, 8, 15, 16, 17, 18 to which the claims shall be restricted. In addition, if either of the groups II or VI is elected the Applicant is required, in reply to this action, to elect a single species from the SEQ. ID. Nos.: 9-14. The reply must also identify the claims readable on the elected species, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered non-responsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species or invention to be examined even though the requirement be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.

The election of an invention or species may be made with or without traverse. To reserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse.

Art Unit: 1647

Should applicant traverse on the ground that the inventions or species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the inventions or species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C.103 (a) of the other invention.

4. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Elly-Gerald Stoica whose telephone number is (571) 272-9941. The examiner can normally be reached on 8:30-17:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brenda G. Brumback can be reached on (571) 272-0961. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1647

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

A handwritten signature in black ink, appearing to read "Lorraine Spector". The signature is fluid and cursive, with a large initial "L" and a long, sweeping underline.

**LORRAINE SPECTOR
PRIMARY EXAMINER**